

ADMINISTRATIVE PANEL DECISION

Surterra Holdings, Inc. v. Domain Administrator, Mid-Year Management, Inc.
Case No. D2024-3576

1. The Parties

The Complainant is Surterra Holdings, Inc., United States of America (“United States”), represented by Nelson Mullins Riley & Scarborough, L.L.P., United States.

The Respondent is Domain Administrator, Mid-Year Management, Inc., United States.

2. The Domain Name and Registrar

The disputed domain name <thesurterra.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 4, 2024. On September 4, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 4, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 12, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on September 12, 2024.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 17, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 7, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 9, 2024.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on October 18, 2024. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a Georgia (United States) corporation that develops and retails cannabis-based medical products. The Complainant received one of the first licenses to operate a Medical Marijuana Treatment Center (“MMTC”) in the state of Florida, United States, when Florida legalized medical marijuana in 2014. Since then, the Complainant has sold a variety of cannabis-based products through a growing number of retail locations in Florida. It now operates “nearly 40” stores in the state, as well as online through the Complainant’s website at www.surterrawellness.com and social media sites. The record includes evidence of advertising and media recognition of the Complainant’s SURTERRA and SURTERRA WELLNESS marks and joint promotions with a prominent celebrity musician from Florida. The record includes an independent publication reporting that by 2021 the Complainant was the second-largest distributor of medical marijuana in Florida.

The Complainant holds these United States trademark registrations:

Mark	Registration Number	Registration Date	Goods or Services
SURTERRA (word)	6309305	March 30, 2021	International Class 35, 44; providing an online directory on physicians and healthcare providers; providing a website with health information on medical marijuana and cannabis and related consulting services
SURTERRA WELLNESS (words and design)	6486561	September 14, 2021	International Class 35, 44; providing an online directory on physicians and healthcare providers; providing a website with health information on medical marijuana and cannabis and related consulting services
SURTERRA WELLNESS	6504839	October 5, 2021	International Class 35, 44; providing an online directory on physicians and healthcare providers; providing a website with health information on medical marijuana and cannabis and related consulting services

The Registrar reports that the disputed domain name was created on August 20, 2024, and was registered in the name of a domain privacy service. After receiving notice of the Complaint in this proceeding, the Registrar identified the underlying registrant as the Respondent, Mid-Year Management, Inc., listing a postal address in Miami Beach, Florida, United States and a contact email address using the domain name <mymngmt.com>. That domain name is not associated with an active website. The Panel notes that the online database of the Florida Division of Corporations shows that a company by that name was registered in Florida in July 2015 but dissolved in September 2018. The Respondent did not reply to emails from the Complainant or the Center, and mail sent to the postal address given in the registration details could not be delivered by courier. Given these facts, it appears that the registration details for the disputed domain name supplied in August 2024 are inaccurate.

The disputed domain name has resolved only to a landing page hosted by the Registrar with third-party, pay-per-click (“PPC”) advertising links. The disputed domain name is associated with a mail server, but there is no evidence in the record of its use to date for emails.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is identical or confusingly similar to its SURTERRA mark, which it incorporates in its entirety, and that the Respondent has no permission to use the mark. There is no evidence that the Respondent has been known by a corresponding name or has other rights or legitimate interests in the disputed domain name. The Complainant cites the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”), section 2.9, for the conclusion that parking the disputed domain name for PPC advertising “does not amount to a *bona fide* offering” of goods or services, where the PPC links “compete with or capitalize on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users”.

The Complainant argues that the Respondent “knew or should have known” of the Complainant’s “highly distinctive” SURTERRA mark when it registered the disputed domain name and more likely than not targeted the Complainant’s mark. The Complainant attaches copies of Internet search results for “Surtterra” showing that the Complainant and its mark appear prominently and repeatedly on the first pages. The Complainant contends that the probability is simply that the Respondent was aware of the distinctive mark and sought to exploit it for commercial gain. In the totality of these circumstances, the association of a mail server suggests the possibility of other bad faith uses.

B. Respondent

The Respondent did not reply to the Complainant’s contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant’s trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark (the registered SURTERRA and SURTERRA-derivative marks) for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the SURTRERRA mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, the word “the”) may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise. The disputed domain name is not comprised solely of dictionary words but incorporates a highly distinctive trademark. It has been used only for PPC advertising for a variety of third parties with no known relation to the Respondent. As indicated in [WIPO Overview 3.0](#), section 2.9, this cannot be deemed a legitimate use in connection with a bona fide offering of goods or services but appears more likely an instance of exploiting a distinctive trademark.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent was likely aware of the Complainant’s distinctive mark, which is not a dictionary word and is preeminent in Internet search results. The Complainant has had an online presence for years, and the Respondent also shows its location as Florida, where the Complainant’s retail stores are located and advertised. Whether or not the Respondent itself has profited from the PPC advertising use of the disputed domain name to date, the Respondent remains responsible for such commercial use of the disputed domain name to attract Internet users to a PPC landing page. This is an instance of bad faith under the Policy, paragraph 4(b)(iv) (attempting to attract Internet users for commercial gain by creating a likelihood of confusion with the complainant’s mark).

While paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, other circumstances also may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The Panel considers that the record of this case reflects that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy. The Panel notes the distinctiveness of the Complainant's trademark and the reputation that it gained quickly, and the composition of the disputed domain name incorporating the exact mark and finds that in the circumstances of this case the use of the disputed domain name for a PPC site does not prevent a finding of bad faith under the Policy.

The Panel notes that the association of a mail server also raises the risk that the disputed domain name could be used in connection with a phishing or other fraudulent email scheme. See [WIPO Overview 3.0](#), section 3.4. The Respondent has not come forward to offer any legitimate reasons for registering the disputed domain name incorporating a highly distinctive trademark, and the fact that the Respondent's registration was made in the name of a company that was dissolved several years earlier, with no current website or correct postal address, reinforces the inference of bad faith.

The Panel finds that the Complainant has established the third element of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <thesurterra.com> be transferred to the Complainant.

/W. Scott Blackmer/

W. Scott Blackmer

Sole Panelist

Date: October 30, 2024